

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barnard *et al.*

Examiner: Gort, Elaine L.

Serial No.: 09/444,254

Art Unit: 3627

Filed: 11/22/1999

Dkt. No.: EN999116

**For: SYSTEM AND METHOD FOR PROJECT PREPARING A PROCUREMENT AND
ACCOUNTS PAYABLE SYSTEM**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANTS

This Reply Brief addresses issues in the Examiner 's Answer mailed May 17, 2006.

RELATED APPEALS AND INTERFERENCES

The Examiner's Answer stated: "The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences."

In response, Appellants have added Appendix A to address the preceding concern in the Examiner's Answer concerning related appeals and interferences.

Appellants have also added Appendix B to ensure compliance with requirements relating to evidence.

GROUND OF REJECTION

The Examiner rejected claims 29-32 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gundewar et al. (US Patent 6,381,610) in view of Oka (US Patent 5,537,591), Examiner's Official Notice, and Microsoft Press Computer Dictionary.

Claim 29

Appellants presented three arguments as to why claim 29 is not unpatentable over Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary. The Examiner's Answer addressed Appellants' the three arguments for claim 29. Appellants next address the arguments in Examiner's Answer with respect to the three arguments for claim 29.

Claim 29: First Argument

Appellants' first argument contends that Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary does not teach or suggest the following feature of claim 29: "wherein said folders and views section, said task title display and selection area, said summary task creation button, and said detailed task creation button visually appear together **in a single contiguous display area** within said playbook summary view" (emphasis added).

The Examiner's Answer admits: "Gundewar ... is silent regarding ... where the folders and views section, task title display and selection area, summary task creation button and the detailed task creation button visually appear together in a single contiguous display area."

The Examiner's Answer presents an exhibit in Appendix A and argues: "Windows 95 which is a printed screen of Windows 95 that illustrates this windowing ability and is presented as Appendix A. The Examiner contends that this screen is contiguous because it is similar to the contiguous screen disclosed in the Applicant's Figure 16/18 which is presented for convenience for reviewers as Appendix B. Although the "documents" have boundaries they are still contiguous as they are connected by the boundaries and exist on one screen."

In response, Appellants acknowledge that it is well known to display multiple items on a single screen as illustrated in the Examiner's Appendix A. However, the pertinent issue is whether it is obvious to modify Gundewar by displaying "said folders and views section, said task title display and selection area, said summary task creation button" in a single contiguous display area contiguously on a screen. Appellants content that the Examiner has not provided a persuasive argument as to why is obvious to so modify Gundewar.

In particular, the Examiner argues that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the information of Gundewar's Figure 3 (marked up and presented as Appendix C) which Examiner contends includes the "playbook summary views" (which incorporates folders and views section, task title display and selection area, summary task creation button and the detailed task creation button of the program storage device) on one divided screen of a windowing environment as taught by Microsoft Press Computer Dictionary, **in order provide users a multitasking interface to view these different documents at the same time on a single contiguous display area**" (emphasis added).

Appellants assert that a divided screen in a windowing environment presents, by

definition, a view of different documents (e.g., text, graphics, etc.) at the same time on a single contiguous display area. Therefore, the Examiner's argument for so modifying Gundewar is based on circular reasoning, namely that it is obvious to display a view of different documents at the same time on a single contiguous display area in order to display a view of different documents at the same time on a single contiguous display area.

The issue that should be addressed is why in particular is it allegedly obvious to display a view of displaying "said folders and views section, said task title display and selection area, said summary task creation button" at the same time on a single contiguous display area. In order to address this issue, one needs to determine whether the prior art suggest a modification of Gundewar in consideration of the specifics of "said folders and views section, said task title display and selection area, said summary task creation button".

Appellants contend that the Examiner's Answer does not cite even one prior art reference to suggest motivation for so modifying Gundewar in consideration of the specifics of "said folders and views section, said task title display and selection area, said summary task creation button". In particular, the citation in the Examiner's Answer of Microsoft Press Computer Dictionary does not provide motivation for so modifying Gundewar. Microsoft Press Computer Dictionary merely discloses that "the screen can be divided into several windows, each of which has its own boundaries and can contain a different document." Microsoft Press Computer Dictionary does not provide any suggestion as to the types of content that should be displayed visually together in different windows of a divided screen.

Hence, the Examiner's Answer appears to be citing Microsoft Press Computer Dictionary for the incorrect proposition that it is obvious to display visually together any arbitrary two

documents in different windows of a divided screen, regardless of the content of the two documents. The Examiner's Answer appears to have made a generic argument alleging that it is obvious to display a view of different documents at the same time on a single contiguous display area irrespective of what the different documents comprise and irrespective of how the different documents relate to each other.

The Examiner's failure to cite prior art for the alleged motivation to so modify Gundewar is contrary to established case law which requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**").

Appellants note the strong reliance in the Examiner's Answer on the "the information of Gundewar's Figure 3 (marked up and presented as Appendix C)" as comprising the content that should allegedly be at the same time on a single contiguous display area. Accordingly, Appellants cite Gundewar, col. 3, lines 38-39 which recites: "FIG. 3 is a representative diagram of a **series of views** of particular data displays of the present invention" (emphasis added). Appellants maintain that the preceding citation in Gundewar suggests that Gundewar intends to

have the data of FIG. 3 displayed serially as a series of view, and not simultaneously on a single contiguous display area.

Accordingly, Appellants content that the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 29.

Based on the preceding first argument, Appellants maintain that claim 29 is not unpatentable over Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary.

Claim 29: Second Argument

Appellants' first argument contends that Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary does not teach or suggest the following feature of claim 29: "designing, implementing, and using a **general procurement and accounts payable (GP/AP) system**" (emphasis added).

The Examiner's Answer admits: "Gundewar ... is silent regarding the system being used for a GP/AP system".

The Examiner's Answer argues: "Oka discloses in the "Summary of the Invention" in column 1, that it is known in the art to provide programming instruction to coordinate the design, implementation and use of an accounting system in order to coordinate the development of an accounting system. See details also under the "Description of the Related Art" in column 1. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the program storage device of Gundewar et al. for use on the development of an accounting system as taught by Oka, in order to coordinate the design, implementation and use of

an accounting system.”

In response to the preceding argument in the Examiner’s Answer, Appellants respectfully contend that the analysis of Okra in the Examiner’s Answer is erroneous and is not applicable to modifying Gundewar. In particular, there is no disclosure anywhere in Oka that “it is known in the art to provide programming instruction to coordinate the design, implementation and use of an accounting system in order to coordinate the development of an accounting system.”

Appellants note that the only mention of “accounting” in the “Background of the Invention and “Summary of the Invention” section of Oka (referred to *supra* for support by the Examiner) is the following recitation in col. 1, lines 52-56: “It is an object of the present invention to provide an apparatus, which can automatically form a system diagram representing a summary of the entire system associated with various data processing operations such as **accounting** processing.” (emphasis added). Appellants maintain that the preceding quote from Oka, col. 1, lines 52-56 most certainly does not disclose that “it is known in the art to provide programming instruction to coordinate the design, implementation and use of an accounting system in order to coordinate the development of an accounting system” as alleged by the Examiner. Since Oka does not disclose what the Examiner alleges, Appellant maintains that the Examiner’s modification of Gundewar by the alleged teaching of Oka is not persuasive.

With respect to the preceding argument in the Examiner’s Answer, the Examiner further states: “Examiner provided the Oka reference to clearly show that accounting software systems exist and have been developed, and thus are old and well known in the art”.

In response, Appellants acknowledge that accounting software systems exist and have been developed and are well known in the art. However, the fact that software systems exist and

have been developed and are well known in the art is not an argument for modifying Gundewar's invention to develop an accounting system via Gundewar's invention. Therefore, the Examiner reason for citing Oka is insufficient to establish a *prima facie* case of obviousness, since the Examiner admits that "Gundewar ... is silent regarding the system being used for a GP/AP system" and the Examiner's stated reason for citing Oka does not establish a persuasive argument for so modifying Gundewar.

Moreover, irrespective of what Oka discloses about an accounting system generically, Oka does not disclose anything **specifically about a general procurement and accounts payable (GP/AP) system** and therefore most certainly does not disclose the feature: "designing, implementing, and using **a general procurement and accounts payable (GP/AP) system**" of claim 29.

The Examiner's Answer further argues that "the program of Gundewar et al. in effect does disclose program instructions capable of being executed to perform the design of computer software (see column 1 line 11) and therefore includes the development of a general procurement and accounts payable system. Although Gundewar et al. does not expressly show the claimed system as being geared toward general procurement and accounts payable data these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of Gundewar et al. would be performed the same regardless of the data. Thus, this descriptive material does not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have

been obvious to a person of ordinary skill in the art at the time the invention was made to perform the step of Gundewar et al. using any type of data. Because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Under this argument the reference of Oka may be considered superfluous.”

In response, Appellants contend that the preceding argument by the Examiner is not persuasive, because Gundewar, col. 1, line 11 discusses the development of computer software only in the context of the prior art and not in the context of the system of Gundewar’s invention.

In further response to the preceding argument in the Examiner’s Answer, Appellants respectfully contend that the feature in claim 29 of “designing, implementing, and using a general procurement and accounts payable (GP/AP) system” is not nonfunctional descriptive material that is not functionally involved in the steps recited, as alleged by the Examiner. Appellants contend that the program instructions capable of being executed to implement Gundewar’s invention would surely be different for development of a general procurement and accounts payable system than for the development of another application such as an engineering design system. As a first example, **designing** a general procurement and accounts payable (GP/AP) system requires steps that are specific to a general procurement and accounts payable (GP/AP) system. As a second example, **implementing** a general procurement and accounts payable (GP/AP) system requires steps that are specific to a general procurement and accounts payable (GP/AP) system. As a third example, **using** a general procurement and accounts payable (GP/AP) system requires steps that are specific to a general procurement and accounts payable (GP/AP) system.

In further response to the preceding argument in the Examiner's Answer, Appellants respectfully contend that the Examiner's Answer has not provided any evidence, or any other analysis, to support the Examiner's allegation that "designing, implementing, and using a general procurement and accounts payable (GP/AP) system" is nonfunctional descriptive material that is not functionally involved in the steps recited, Appellants contend that the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 29.

Based on the preceding second argument, Appellants maintain that claim 29 is not unpatentable over Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary.

Claim 29:Third Argument

Appellants' third argument contends that Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary does not teach or suggest the following feature of claim 29: "said playbook database comprising a plurality of templates of information relating to said designing, implementing, and **using** said GP/AP system" (emphasis added).

Appellants contend that Gundewar's disclosure is restricted to templates for "planning" aspects of a project. Gundewar does not teach or suggest templates for "**using**" the system (i.e., the GP/AP system allegedly generated by the project). All of the templates discussed and disclosed by Gundewar relate to project planning, and none of the templates discussed and disclosed by Gundewar relate to "**using**" the system generated by the project.

Appellants note that in Gundewar's abstract, preamble of independent claim 1 and 11, and the Summary of the Invention (in the three aspects of the invention) describes Gundewar's

invention as “a method for automated project **planning**” (emphasis added). The Brief Description of the Drawings in Gundewar describes the drawings as pertaining to “automated project **planning** tasks” (emphasis added). The description of the system 10 of FIG. 1 in col. 4, lines 14-15 states: “In general, system 10 allows a user to complete project **planning** tasks and procedures ...” (emphasis added).

In addition, the description of the flow chart of FIG. 4 in Gundewar, col. 8, lines 13-15 for the method of Gundewar’s invention states: “In FIG. 4, an embodiment of a flowchart of a method for automating project **planning** tasks and procedures according to the present invention is shown” (emphasis added). Appellants contend that no step in FIG. 4 for Gundewar’s method is directed to “**using**” the system generated by the project.

Moreover, the Examiner has not presented any analysis to support the Examiner’s contention that Gundewar teaches “**using**” the GP/AP system. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 29.

The Examiner’s Answer argues that Gundewar discloses “that “a plurality of templates of information relating to the design, implementation, and use of the computer software system” include templates as shown in figure 3 which are used for the information shown in Tables A-C which includes “information relating” to the use of the system which is being designed. For example Table A discusses data for defining business needs which Examiner construes as relating to the system’s use as the system is being designed to carry out these needs. Templates of Gundewar et al. relate to “using” the system as they are used to contain data which defines the system and how the system will be used when completed or modified.”

In response, Appellants respectfully contend that the preceding argument in the

Examiner's Answer relating to "Defining Business Need" relates to planning and design and not to using the system, as evidenced by the subtopics under "Defining Business Need" in Gundewar, Table B; said subtopics being: "Describe Business Problem/opportunity", "Define Scope of Business Need"; "Determine Impact of Business Need"; and "Outline Project Scope".

Based on the preceding third argument, Appellants maintain that claim 29 is not unpatentable over Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary.

Claims 30-31

In the Appeal Brief, Appellants argued that Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary does not teach or suggest the following feature of claims 30-31: "enabling communication between team members of a team and the playbook database via a server coupled to the playbook database and an intranet coupled to both the server and the team members, said team members having responsibility for said designing and implementing of said GP/AP system."

The Examiner's Answer argues: "Column 7, line 38 discloses team members submitting filled out templates and therefore team members are responsible for designing and implementing the system. "

In response, Appellants contend that the preceding argument by the Examiner is not persuasive, because Gundewar, col. 7, line 38 discloses only that templates may be filled out online by team members, which is not a disclosure of: "said team members having responsibility for said designing and implementing of said GP/AP system".

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 30-31.

Based on the preceding argument, Appellants maintain that claims 30-31 are not unpatentable over Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary.

Claim 32

In the Appeal Brief, Appellants argued that Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press Computer Dictionary does not teach or suggest the following feature of claim 32: "wherein said generating and displaying the playbook summary view, said generating and displaying the summary task template, and said generating and displaying the detailed task template are utilized during performing at least one of designing the GP/AP system; implementing the GP/AP system; using the GP/AP system; optimizing a solution for out-sourcing procurement of goods and services under the GP/AP system; training service providers of services to the customer; managing said service providers to assure quality of service from said service providers; managing a project relating to the GP/AP system; and optimizing the GP/AP system, said optimized GP/AP system being characterized by lower costs, a paperless process, and more comprehensive service with a shorter cycle time."

The Examiner's Answer argues that "Gundewar et al. teaches **using the system** for performing the design of a computer software project.... First the Examiner contends that the program of Gundewar et al. in effect does disclose program instructions capable of being executed to perform the design of computer software (see column 1 line 11) and therefore

includes the development of a general procurement and accounts payable system.”

In response, Appellants contend that the preceding argument by the Examiner is not persuasive, because Gundewar, col. 1, line 11 discusses the development of computer software only in the context of the prior art and not in the context of the system of Gundewar’s invention.

The Examiner’s Answer further argues: “Although Gundewar et al. does not expressly show the claimed system as being geared toward general procurement and accounts payable data these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of Gundewar et al. would be performed the same regardless of the data. Thus, this descriptive material does not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the step of Gundewar et al. using any type of data. Because such data does not functionally related to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Under this argument the reference of Oka may be considered superfluous.”

In response to the preceding argument in the Examiner’s Answer, Appellants respectfully contend that the feature in claim 32 of “using the GP/AP system” is not nonfunctional descriptive material that is not functionally involved in the steps recited, as alleged by the Examiner. Appellants contend that the program instructions capable of being executed to implement Gundewar’s invention would surely be different for development of a general procurement and accounts payable system than for the development of another application such as an engineering

design system. In particular, **using a general procurement and accounts payable (GP/AP) system** requires steps that are specific to a general procurement and accounts payable (GP/AP) system.

In further response to the preceding argument in the Examiner's Answer, Appellants respectfully contend that the Examiner's Answer has not provided any evidence, or any other analysis, to support the Examiner's allegation that "using the GP/AP system" is nonfunctional descriptive material that is not functionally involved in the steps recited. Accordingly, Appellants contend that the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 32.

In addition, the Examiner states: "Examiner provided the Oka reference to clearly show that accounting software systems exist and have been developed, and thus are old and well known in the art."

In response, Appellants acknowledge that accounting software systems exist and have been developed and are well known in the art. However, the fact that software systems exist and have been developed and are well known in the art is not an argument for modifying Gundewar's invention to develop an accounting system via Gundewar's invention. Therefore, the Examiner reason for citing Oka is insufficient to establish a *prima facie* case of obviousness, since the Examiner admits that "Gundewar ... is silent regarding the system being used for a GP/AP system" and the Examiner's stated reason for citing Oka does not establish a persuasive argument for modifying Gundewar.

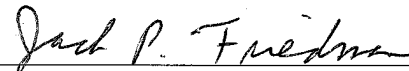
Based on the preceding third argument, Appellants maintain that claim 32 is not unpatentable over Gundewar in view of Oka, Examiner's Official Notice, and Microsoft Press

Computer Dictionary.

SUMMARY

In summary, Appellants respectfully request reversal of the rejection of claims 29-32 as allegedly being unpatentable under 35 U.S.C. §103(a) over Gundewar et al. in view of Oka (US Patent 5,537,591), Examiner's Official Notice, and Microsoft Press Computer Dictionary.

Respectfully submitted,



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APPENDIX A - RELATED PROCEEDINGS

There are no proceedings identified in the "Related Appeals and Interferences" section.

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APPENDIX B - EVIDENCE

There is no evidence entered by the Examiner and relied upon by Appellants in this
appeal.